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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,079	09/11/2000	Brian M. Romansky	E-996	4596

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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/658,079

Applicant(s)
Brian M. Romansky

Examiner
Pierre E. Elisca

Art Unit
3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/18/2023.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION
RESPONSE TO AMENDMENT

1. This Office action is in response to Applicant's amendment, filed on 06/18/2003.
2. Claims 1-26 are remained and claims 27-41 are added.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-41 are rejected under 35 U.S.C. 102 (b) as being anticipated by Liechti et al. (5,715,164).

As per claims 1, 3-10, 12-14, 17, 20, and 24-26 Liechti discloses a communications system/method that has a host computer in a data center communicates with a multiplicity of electronic postage meters via telephone dial-up lines to conduct telemeter setting transactions (which is equivalent to Applicant's claimed invention wherein it is stated that a method of metering digital content having a message to be presented to a plurality of users of a communications network), comprising:

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embedding a code in said message (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, col 2, lines 1-7); detecting the embedded code (see., abstract, col 1, lines 20-31); and based on the detected embedded code, counting the number of times the message is presented to a user of the communications network (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65).

As per claims 2, 16, and 19 Liechti discloses the claimed method, wherein the communications network includes the internet (see., col 3, lines 47-56, specifically wherein it is stated that host computer in data center is capable of communicating with the meters via telephone dial up lines, and therefore, it is inherent to realize that host computer is also capable of connecting with the meters via Internet since Fig 1 of Liechti discloses a plurality of modems).

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As per claims 11, 15, 18, 21, and 23, Liechti discloses the claimed method wherein the digital content is indicative of an advertisement (see., col 10, lines 1-5, specifically wherein it is stated that computer 103 may utilize the hardware information for advertisement).

As per claims 22, 27, and 29-41 Liechti discloses a communications system/method that has a host computer in a data center communicates with a multiplicity of electronic postage meters via telephone dial-up lines to conduct telemeter setting transactions (which is equivalent to Applicant's claimed invention wherein it is stated that a method of metering digital content having being presented to users of a communication network, the digital content being contained in a network data stream and including a message embedded with a code to allow a number times the message is presented to a user to be counted see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65, comprising:
monitoring the network data stream to detect data representative of the embedded code (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and

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ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, col 2, lines 1-7);

recording a number of times the data representative of the embedded code is detected, the number of times the data representative of the embedded code is detected being indicative of presentation of the message to a user (see., abstract, col 1, lines 20-31, specifically wherein it is stated that verifying the meter's identity and ascertains the availability of funds in the user's account and supplies a combination code to the meter or to the user, and col 2, lines 35-45, specifically wherein it is stated that the host computer may collect statistical data from each meter, and may impose a cumulative postage amount limit, a time limit and/or a piece limit on the meter, please note that collecting statistical data also includes counting the number of times the message is presented and so on, col 5, lines 23-65); and

calculating a charge (or charge class) for presenting the message based on the computer of times the data representative of the embedded code is detected (see., abstract, col 1, lines 20-31, col 2, lines 14-27, col 4, lines 50-60, specifically wherein it is stated that charge class 1 includes items with a postage value of 29 cents, charge class 2 includes items with postage values between 30 cents and 35 cents, please note that charge classes i.e class 1 and class 2 are interpreted as a process of calculating a charge).

As per claim 28, Liechti discloses the claimed method, wherein the communications network includes the internet (see., col 3, lines 47-56, specifically wherein it is stated that host computer in

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data center is capable of communicating with the meters via telephone dial up lines, and therefore, it is inherent to realize that host computer is also capable of connecting with the meters via Internet since Fig 1 of Liechti discloses a plurality of modems).

RESPONSE TO ARGUMENTS

5. Applicant's arguments filed on 06/18/2003 have been fully considered but they are not persuasive.

REMARKS

6. In response to Applicant arguments, Applicant argues that the prior art of record (Liechti) taken alone or in combination fails to disclose:

“a method or system for metering messages presented via a communication network”. However, the Examiner respectfully disagrees because Liechti discloses in fig 1, col 47-67 that a data center 15 and a multiplicity of electronic postage meter 101-1 through 101-p which are structurally identical, where p is integer. Host computer 103 in data center 15 is capable of communicating data with the meters VIA telephone dial-up lines (via telephone dial-up modems or via communication network).

Conclusion

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7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

(703) 305-7687



Pierre Eddy Elisca

Patent Examiner

September 15, 2003